

### **REMARKS**

Applicants submit these Remarks in reply to the Final Office Action mailed September 15, 2008. Claims 1-25, 28, and 29 are pending in this application, of which claims 1, 21, 28, and 29 are independent. Applicants have amended claims 1, 21, 23, 28, and 29 as provided above. By this Amendment, no new matter has been introduced.

In the Final Office Action, the Examiner took the following actions:

- (1) rejected claim 29 under 35 U.S.C. § 102(a) as being anticipated by PCT Patent Application Publication WO 03/005192 ("*Reimer*");
- (2) rejected claims 21-24<sup>1</sup> under 35 U.S.C. § 103(a) as being unpatentable over *Reimer* in view of U.S. Patent No. 5,551,047 ("*Mori*");
- (3) rejected claims 1-8, 10, 12-20 and 28<sup>2</sup> under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Pub. 2003/0140267 ("*Abbondanzio*") in view of *Reimer* and further in view of *Mori*;
- (4) rejected claim 25 under 35 U.S.C. § 103(a) as being unpatentable over *Reimer*, in view of *Abbondanzio*, and further in view of *Mori*; and
- (5) rejected claim 9 under 35 U.S.C. § 103(a) as being unpatentable over *Abbondanzio*, in view of *Reimer*, further in view of *Mori*, and further in view of U.S. Patent Application Publication 2004/0255191 ("*Fox*"); and
- (6) rejected claim 11 under 35 U.S.C. § 103(a) as being unpatentable over *Abbondanzio*, in view of *Reimer*, further in view of *Mori*, and further in view U.S. Patent Application Publication 2003/0046394 ("*Goddard*").

Applicants respectfully traverse these rejections, as follows.

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<sup>1</sup> Although the Final Office Action indicates claims 22-24 are included in the rejection, the Final Office Action does not address claims 22-24.

<sup>2</sup> The Final Office Action does not include claim 1 in the heading, but includes claim 1 in the analysis of claim 28.

**I. Claims 22-24, 26, and 27 Are Not Addressed in the Final Office Action**

Fundamentally, the present Office Action is prematurely final in that it does not address claims 22-24, 26, and 27, which were pending prior to the Final Office Action. Although the Final Office Action states these claims 22-24 are rejected under 35 U.S.C. § 103(a), no explanation is given in the Final Office Action. Those claims were last addressed in the previous Office Action of February 29, 2008 ("Previous Office Action"), in which the Examiner asserted a 35 U.S.C. § 102(a) rejection based on *Reimer*. But claims 22-24, as amended, cannot be anticipated by *Reimer*, as evidenced by the Examiner's admissions and reliance on other art for parent independent claim 21. In other words, the rejection in the previous Office Action cannot be incorporated into the Final Office Action for rejecting claims 22-24. Further, claims 26 and 27 are not addressed in any way in the Final Office Action.

Because the Final Office Action does not address these claims, an Advisory Action would be an inappropriate response to this Amendment. M.P.E.P. § 710.6 specifies that, at a minimum, the Office will issue a new Action and set a new period of Reply when, as here, the Action does not address all pending claims.

Applicants also note that the subject matter of pending claim 23 (which was substantially amended in the prior Amendment) has never been addressed by the Office during prosecution of this application. That claim recites "shifting is accomplished by copying the service from the first computer to the second computer." None of the cited references disclose, teach, or suggest "shifting is accomplished by copying the service from the first computer to the second computer," as claimed by Applicants.

Applicants request allowance of non-addressed claims 22-24, 26, and 27. In any case, this Amendment should be addressed by an Office Action with a new period of response, rather than an Advisory Action. Thus, Applicants request withdrawal of the finality of the current Office Action and consideration of the present Reply and Amendment.

**II. 35 U.S.C. § 102(a)**

Applicants respectfully traverse the Examiner's rejection of claim 29 under 35 U.S.C. § 102(a), because *Reimer* does not anticipate that claim, as amended. To establish that *Reimer* anticipates Applicants' claim 29 under 35 U.S.C. § 102(a), the Examiner must show that *Reimer* discloses the "identical invention . . . in as complete detail as is contained in the . . . claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Additionally, the "elements must be arranged as required by the claim." See M.P.E.P. § 2131, citing *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). As shown below, *Reimer* does not disclose the identical invention as claimed, and Applicants respectfully traverse the rejection.

Amended independent claim 29 recites "keeping the number of computers that are re-installing the operating system smaller than the number of computers that are not re-installing the operating system." *Reimer* does not disclose this recitation. In support of the rejection, the Examiner cites *Reimer*, p. 18, II. 18-21, which discloses cycling servers but is totally silent with regard to the number of computers reinstalling at any one time:

The invention also has the advantage that the life span of a server is increased due to the cycling of the servers (rebooting due to long up-time)

and it also increases the security of the system since an uncorrupted version of the preconfigured operating system is downloaded each time the server is rebooted.

*Reimer*, p. 18, ll. 18-21.

Not only is this passage silent regarding Applicants' claim recitations, *Reimer* also contains other passages that are exactly opposite of Applicants' claims. For example, *Reimer* teaches that all of the servers can be unavailable during the reinstallation process:

If no alternative server is available, the control unit may boot a spare server (not shown), by using the process described in connection with figure 5, to create a server with the same preconfigured operating system as the one that should be shut 10 down and rebooted. If there is no spare server available, new users will be denied access to any server until the server is rebooted.

*Reimer*, p. 14, ll. 7-11 (emphasis added).

Therefore, *Reimer* does not disclose "keeping the number of computers that are re-installing the operating system smaller than the number of computers that are not re-installing the operating system," as recited in Applicants' amended claim 29. Instead, *Reimer* contemplates a system where no computers remain available for access during the reinstallation process. *Id.*

Consequently, *Reimer* does not disclose, teach, or suggest all recitations of Applicants' amended independent claim 29. Applicants respectfully request that the Examiner withdraw the 35 U.S.C. § 102(a) rejection based on *Reimer* with respect to claim 29.

**III. 35 U.S.C. § 103(a)**

Applicants respectfully traverse the Examiner's rejections of claims 1-28 under 35 U.S.C. § 103(a). A *prima facie* case of obviousness has not been established with respect to these claims.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). "A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." M.P.E.P. § 2145. Furthermore, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

"[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s)

between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Here, a *prima facie* case of obviousness has not been established with regard to claims 1-28, as amended, because the Examiner has not properly explained why the differences between Applicants’ claims and the prior art would have been obvious to one of ordinary skill in the art.

**A. The references do not teach “keeping the number of computers that are re-installing the operating system smaller than the number of computers that are not re-installing the operating system.”**

Applicants’ amended independent claims 1 and 21 recite, among other things, “keeping the number of computers that are re-installing the operating system smaller than the number of computers that are not re-installing the operating system.” Applicants have explained with respect to the 35 U.S.C. § 102(a) why *Reimer* does not teach or suggest these recitations. The other cited references do not teach, suggest, or disclose these claim recitations either.

Therefore, no combination of the cited references teaches, suggests, or discloses all recitations of amended independent claims 1 and 21.

**B. The references do not teach “[copying] a service that is running on the earlier detected blade from the earlier detected blade to the new blade.”**

Amended independent claim 28 recites, among other things, “[copying] a service that is running on the earlier detected blade from the earlier detected blade to the new blade.” This recitation was previously presented in claim 23, but, as noted above, was not addressed in the Final Office Action. The subject matter of amended claim 28 substantially includes copying a service from a blade that runs the service, rather than

from a central repository. None of the cited references teach, suggest, or disclose this claimed subject matter. Therefore, no combination of the cited references teaches, suggests, or discloses all recitations of independent claims 1, 21, and 28.

**C. The 35 U.S.C. § 103(a) rejections should be withdrawn.**

As shown above, the cited references do not teach, suggest, or disclose all recitations of amended independent claims 1, 21, and 28. Therefore, the differences between the cited references and the Applicants claims have not been properly ascertained. Accordingly, the Final Office Action does not clearly articulate a reason why one of ordinary skill in the art would have modified the cited references to achieve the subject matter of independent claims 1, 21, and 28. Dependent claims 2-20 and 22-27 each necessarily contain the recitations of amended independent claims 1 and 21. For at least this reason, no *prima facie* case of obviousness exists with respect to claims 1-28. Applicants, therefore, respectfully request that the Examiner withdraw the 35 U.S.C. § 103(a) rejections of claims 1-28.

**IV. Conclusion**

Applicants respectfully request withdrawal of the finality of the current Office Action. Applicants also respectfully request that this Amendment be entered by the Examiner, placing claims in condition for allowance. Applicants submit that the proposed amendments do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner. Applicants have made a good faith attempt to present allowable claims.

Furthermore, as previously noted, the Examiner should not respond via Advisory Action. Instead, the Examiner must issue a new Action, if not allowing the claims, because the Final Office Action did not address all the pending claims, and now does not fully address the amended independent claims in view of the Amendment.

Applicants request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims. If the Examiner should dispute the allowability of the claims after considering the above, please contact the Applicants' undersigned representative, below.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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